

REMARKS/ARGUMENTS

This amendment/response is submitted in response to the Office Action dated December 30, 2005. Reconsideration and allowance are requested.

Claims 21-24 remain in this application. Claims 1-20 were previously canceled.

Claim Rejection Under 35 USC 103

In the Office Action, claim 21 was rejected under 35 USC 103(a), as being unpatentable over Yoshiaki (JP 63-297949) in view of Redmond (U.S. Patent Number 4,246,753). The counsel for assignee respectfully traverses.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2143. The counsel for assignee respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

Yoshiaki or Redmond, either individually or when combined, do not teach all of the limitations of claim 21. The Examiner acknowledged that Yoshiaki does not explicitly disclose the details of the generator assembly but rejected claim 21 by combining Redmond with Yoshiaki and arguing that Redmond discloses a waterwheel and inverter in the assembly in the same field of the endeavor for the purposes of generating electricity. The Examiner further commented that,

"Redmond also discloses the generating station 56 can be used to supply an electrical distribution station with terminal T1, T2, T3 and T4 to which any number of appliances or other feeding lines may be attached. Therefore, the inverter controlling the AC electric power generator for converting the AC electric power to a

desired voltage and frequency are inherent in the system and using invert on AC generator to provide AC power is well known in the art."

Counsel for assignee vigorously traverses because Redmond does not teach an inverter as claimed. In fact there is no mention of an inverter, as claimed, anywhere in Redmond. Redmond shows in FIG. 2 that the electric generator 52 and the light bulb (load) 54 are connected directly and not through an inverter. Additionally, Redmond does not disclose the details of generating station 56 so it is impossible to conclude that an inverter is included in the generating station 56. Therefore, since an inverter, as claimed, is not taught or suggested by Yoshiaki or Redmond, claim 21 is not obvious under *In re Vaeck*.

Claim Rejection Under 35 USC 103 Using Inherency

The Examiner also relied upon the theory of inherency to reject claim 21. The Examiner stated, "the inverter controlling the AC electric power generator for converting the AC electric power to a desired voltage and frequency are inherent in the system and using invert on AC generator to provide AC power is well known in the art." In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art. See MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See MPEP 2112 and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner's position that it is inherent that "the inverter controlling the AC electric power generator for converting the AC electric power to a desired voltage and frequency" is present because "generating station 56 can be used to supply an electrical distribution station with terminal T1, T2, T3 and T4 to which any number of appliances or other feeding lines may be attached," is not legally supported because the inherent characteristic **does not** necessarily flow from the teachings of the applied prior art. The Examiner appears to be concluding that an inverter must be present because inverters are well known in the art and an electrical distribution station having several terminals, which can be connected to any number of appliances, exists. The Examiner is ignoring the possibility that the electrical distribution system

is nothing more than a multiplexer or some other type of distribution system that does not necessarily use an inverter. In fact, there is absolutely nothing in the teachings of Redmond which would suggest that an inverter is required. Therefore, in light of these remarks counsel for assignee requests that the Examiner withdraw his inherency rejection of the claim 21.

Claim Rejection Under Obviousness Type Double Patenting

In the Office Action, the Examiner rejected claims 21-24 under the judicially created doctrine of obviousness-type double patenting over claims 8 and 9 of U.S. Patent No. 6,698,223 in view of Yoshiaki (JP 63-297949). Counsel for assignee respectfully traverses. In this rejection the Examiner again used inherency to show the inverter found in claims 21-24. Specifically, the Examiner stated,

"Redmond discloses the generating station 56 can be used to supply an electrical distribution station with terminal T1, T2, T3 and T4 to which any number of appliances or other feeding lines may be attached. Therefore, the inverter controlling the AC electric power generator for converting the AC electric power to a desired voltage and frequency are inherent in the system."

For the same reasons as argued above counsel for assignee does not believe that the inverter is inherent to Redmond's teachings because the use of an inverter **does not** necessarily flow from the teachings of the applied prior art. Therefore, in light of these remarks counsel for assignee requests that the Examiner withdraw his rejection of claim 21-24 under the judicially created doctrine of obviousness-type double patenting.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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Amdt. dated March 29, 2006
Reply to Office Action of December 30, 2005

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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